

# REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 8 and 13-42 are pending in the application.

Basis for the amendment to claims 21, 22 and 24 can be found in the present specification including at proviso (iv) in original claim 1. No new matter has been added.

Basis for new claim 26 can be found in the present specification including at page 9, lines 9-25 and pending claim 15. No new matter has been added.

Basis for new claim 27 can be found in the present specification including at page 5, lines 16 and 22, and at pending claim 14. No new matter has been added.

Basis for new claims 28-42 can be found in the present specification including at pages 14-15, examples 1-6, 9-12, and 14 -18. No new matter has been added.

The Applicants respectfully traverse the restriction requirement withdrawing claims 19 and 20 from consideration. The original restriction requirement in this application was between Formulae I and II, see Office Action dated October 3, 1997, and not between individual species of Formulae I. Formula I was elected for prosecution in the above-identified application. Claims 19 and 20 clearly refer to a species of Formula I (compound 13 on page 14 of the present specification) which was originally believed to be included in claim 1. Accordingly, Applicants request that the Examiner withdraw the restriction requirement to claims 19 and 20.

The rejection of claim 15 under 35 U.S.C. § 112, first and second paragraphs, is respectfully traversed. The Examiner argues that the process steps will not afford products where  $R_1$  is not hydrogen or products wherein  $n$  is 2. Page 9, lines 9-25 of the present specification demonstrates how to formulate compounds in which  $n$  is 2. The Applicants respectfully submit that claim 15 fully complies with Section 112. Accordingly, withdrawal of the Section 112 rejection is respectfully requested.

The rejection of claims 21-25 under 35 U.S.C. § 102 over Hopp is obviated by the amendments to claims 21-25 shown above which exclude the specific compounds disclosed at column 2, line 35 of Hopp. Accordingly, withdrawal of the Section 102 rejection is respectfully requested.

The rejection of claims 8, 14-18 and 21-25 under 35 U.S.C. § 103(a) over Hopp is respectfully traversed. The claimed invention is not obvious from Hopp for the following reasons.

The Examiner argues that the claims recite isomers or homologs of the compounds disclosed in Hopp and differ only by the placement of the alkyl on the benzene ring. By use of the term "isomers" it is believed that the Examiner is referring to "position isomers" which are defined by MPEP 2144.09 as "compounds having the same radicals in physically different positions on the same nucleus." Homologs are defined by MPEP 2144.09 as "compounds differing regularly by the successive addition of the same chemical group, e.g., by  $-CH_2-$  groups."

The Applicants respectfully submit that Hopp does **not** disclose the use of alkyls substituted on the benzene ring, but rather only the use of **isopropyl** or **tert-butyl**. See column 1, line 39 of Hopp. Thus, the only compounds recited in the claims of the subject application that can be a "position isomer" of the compounds disclosed in Hopp are those in which only one of  $R_3$ ,  $R_4$ ,  $R_6$  and  $R_7$  is isopropyl or tert-butyl, the remaining groups  $R_3$  through  $R_7$  and  $R_1$  are hydrogen,  $R_2$  is methyl, and  $n$  is 1. Furthermore, the only compounds recited in the claims of the subject application which can be a "homolog" of the compounds disclosed in Hopp are those in which  $R_5$  is isopropyl or tert-butyl, all of  $R_3$ ,  $R_4$ ,  $R_6$  and  $R_7$  are hydrogen,  $R_2$  is methyl, and  $n$  is 2. All other compounds recited in the claimed invention cannot be position isomer or homolog of the compounds disclosed in Hopp.

New claims 27-42 do not include an isopropyl or tert-butyl compound present on the benzene ring. Therefore, the compounds recited in claims 27-42 cannot be position isomers or homologs of the compounds recited in Hopp. For these reasons, claims 27-42 are not obvious over Hopp.

The Applicants respectfully submit that homology and isomerism are not substitutes for a prima facie case of obviousness and they are only a relevant fact in the determination of obviousness. Claims 8, 14-18 and 21-25 recite novel compounds and compositions which are not disclosed in Hopp. The experimental evidence disclosed in the present specification demonstrates the unexpected advantages of the claimed compounds compared to those disclosed in Hopp. Hopp only discloses that their

compounds have a microbicide effect on staphylococcus epidermis and aureus, and candida albicans. In contrast, the claimed compounds and compositions exhibit a microbicide effect against e-coli (Tables on pages 19, 21, 25, and 27), as well as anti-fungal properties (Tables on pages 23 and 24). Hopp does not disclose these advantages and therefore cannot make obvious the compounds and compositions recited in claims 8, 13-18 and 21-25. Accordingly, withdrawal of the Section 103 rejection is respectfully requested.

The rejection of claims 8, 13-18 and 21-25 under 35 U.S.C. § 103(a) over Sipos is respectfully traversed. The claimed invention is not taught or suggested by Sipos for the following reasons.

The Examiner admits that Sipos does not disclose the claimed compounds. However, the Examiner argues that the group III phenol alkanols disclosed in Sipos generically teach the claimed compounds.

The Applicants respectfully submit that Sipos teaches that the large list of group III phenol alkanols cited by the Examiner are only "potentiators" (column 4, lines 23 and 55). Potentiators are taught as enhancing the activity of an antimicrobial agent, not that the potentiator is an antimicrobial agent (column 3, lines 15-18).

In contrast, the presently claimed compounds are antimicrobial agents, disinfectants, deodorants, antimycotics or preservatives, not merely potentiators, as demonstrated by the experimental results disclosed in the Examples of the present specification. Sipos does not teach or suggest that any species in the group III phenol

alkanols would have antimicrobial, disinfectant, deodorant, antimycotic or preservative properties and therefore cannot make obvious use of these compounds as an antimicrobial agent, disinfectant, deodorant, antimycotic or preservative. For these reasons, the claimed compounds and compositions cannot be obvious over Sipos. Accordingly, the Section 103 rejection over Sipos should be withdrawn.

The rejection of claim 15 under 35 U.S.C. § 103(a) over Hafner in view of Vogel is respectfully traversed. Claim 15 is not taught or suggested by the theoretical combination of Hafner and Vogel for the following reasons.

The Examiner admits that Hafner does not teach the claimed step (a) (column 3 of Hafner) and that some of the reactants differ as to the substituents present. The Examiner argues that Vogel teaches the claimed step (a).

There is no motivation in either of the cited references to follow the claimed step (a) to form the specific monoalkylated malonic acid alkyl esters claimed and then follow the claimed steps (b) through (d) to form the specific alcohols presently claimed. The Applicants respectfully submit that the Examiner is unfairly relying on hindsight gleaned from the present specification and is improperly using the present specification as blueprint to piece the references together.

The Examiner admits that Hafner uses different reactants and thus forms different products than those presently claimed. The Examiner merely argues that the use of a new starting material in an otherwise old process is considered obvious. The

Applicants respectfully direct the Examiner's attention to In re Ochiai, 37 USPQ2d 1127, 1113 (Fed. Cir. 1995), in which the Federal Circuit recently stated that:

"when any applicant properly presents and argues suitable method claims, they should be examined in light of all ... relevant factors, free from any presumed controlling effect of Durden or any other precedent."

The Examiner has provided no motivation or teaching in any of the cited references which would direct one of ordinary skill in the art to ignore the teachings in Hafner and use different reactants (as presently claimed) and then change the process of Hafner and use part of the method disclosed in Vogel. For these reasons, the Applicants respectfully submit that the Examiner has not provided sufficient evidence to support a prima facie case of obviousness and the Section 103 rejection should be withdrawn.

Even if the references were combined, the theoretical combination of Hafner and Vogel would not make obvious the method recited in claims 15 and new claim 26. The theoretical combination of Hafner and Vogel provides a method which makes a different alcohol than those claimed because Hafner teaches the use of different reactants than those in the claimed method.

Furthermore, the claimed compounds have unexpected properties not disclosed in the cited references. As discussed above, the claimed compounds exhibit antimicrobial, disinfectant, deodorant, antimycotic or preservative properties. Hafner only discloses that the alcohols disclosed therein provide fragrance properties.

U.S. Serial No. 08/860,007  
October 5, 1998  
Page 18

For these reasons, the claimed method is not taught or suggested by the theoretical combination of Hafner and Vogel. Accordingly, withdrawal of the Section 103 rejection is respectfully requested.

In view of all of the rejections and objections of record having been addressed, it is believed that the subject application is in condition for allowance and notice to that effect is earnestly solicited.

Respectfully submitted,

Farkas & Manelli, PLLC

By

  
Jeffrey S. Melcher

Reg. No.: 35,950

Tel. No.: (202) 261-1045

Fax. No.: (202) 887-0336

Customer No. 20736